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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,329	11/09/2001	Miruka Ishii	09812.0170-00000	5910
22852 7590 01/25/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER EWART, JAMES D	
			ART UNIT	PAPER NUMBER
			2617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/037,329	Applicant(s) ISHII, MIRUKA	
	Examiner James D. Ewart	Art Unit 2617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on October 17 2006 amendment.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15,26-40 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,9,11-15,26,27,31,33-40 and 42 is/are rejected.
- 7) ☒ Claim(s) 7, 10, 28, 29, 30 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Arguments***

1. The applicant's arguments regarding prior art rejections, filed October 17, 2006, have been fully considered by the Examiner, but are considered moot in view of new grounds of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6,8,9,11-15,26,27,31,33-40 & 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferber (U.S. Patent Publication No. 2001/0032193) in view of Lee (US Patent No. 6,417,330) and further in view of Strietzel (U.S. Patent Publication No. 2001/0051517)

Referring to claims 1, 26, 38, 39, 40 and 42, Ferber teaches a data communication system comprising: a first terminal device configured to transmit content and content provider identification data identifying the provider of the content (Figure 1; 40, 60); a server device configured to receive and store the transmitted content and content provider identification data (Figure 3, 350); and a second terminal device configured to transmit user identification data to the server device (Figure 1, 20 and 30), configured to receive and store the content from the server device based on the user identification data (Figure 4, 0024 & 0042); wherein the server device stores first account information corresponding to the content provider identification data

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and second account information corresponding to the user identification data (Figure 1, 0024 & 0026 (for accounting purposes and to pay the advertisers information regarding the advertisers is stored / kept)), the server device incrementing first amount information in said first account information when receiving the content from the first terminal device (Figure 1, 60 (amount owed is incremented)), the server device decrementing second amount information in the second account information when transmitting the content to the second terminal device (0029 (amount owed is decremented)); but does not teach and configured to reproduce the stored content upon detection of an incoming call. Lee teaches configured to reproduce the stored content upon detection of an incoming call (Column 1, Lines 49-61). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ferber with the teaching of Lee of reproducing the stored content upon detection of an incoming call to provide a user preferred ring tone (Column 1, Lines 49-51). Lee further teaches wherein the reproduction is associated with a ring tone, but does not teach wherein the ring tone is associated with an advertisement content that compensates a subscriber for listening to the ad and the reproduction of the ad causes the communication unit to transmit to the server device a reproducing condition of the content reproduced. Strietzel teaches wherein the ring tone is associated with an advertisement content that compensates a subscriber for listening to the ad (0005, 0033 & 0048) and the reproduction of the ad causes the communication unit to transmit to the server device a reproducing condition of the content reproduced (0061 – 0064). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ferber and Lee with the teaching of Strietzel wherein the ring tone is associated with an advertisement content that

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compensates a subscriber for listening to the ad and the reproduction of the ad causes the communication unit to transmit to the server device a reproducing condition of the content reproduced to subsidize service costs (0006).

Referring to claim 2, Ferber, Lee and Strietzel teach the limitations of claim 2 but do not teach using an external settlement center or outsourcing work. However, at the time of the invention it was well known to use an external settlement center or outsource work and thus, the Examiner takes official notice of using an external settlement center or outsourcing work. Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Ferber, Lee and Strietzel of using an external settlement center or outsourcing work to have others do work that is not your forte.

Referring to claims 3 and 27, Ferber teaches wherein the second terminal device comprises: a storing unit configured to store the content transmitted from the server device (0042 and figure 4); a reproducing unit configured to retrieve the content from the storing unit and reproduce the retrieved content (0042, viewing or showing the coupon requires at least temporary storage), but does not teach an incoming call detecting unit configured to detect an incoming call from a third terminal device; and a controlling unit configured to, if the incoming call detecting unit detects an incoming call from the third terminal device, cause the reproducing unit to reproduce the content; configured to establish a connection with the other terminal device in response to an operation performed by a user while the content is being reproduced; and configured to terminate the reproduction of the content once the connection

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with the third terminal device is established. Lee teaches an incoming call detecting unit configured to detect an incoming call from a third terminal device; and a controlling unit configured to, if the incoming call detecting unit detects an incoming call from the third terminal device, cause the reproducing unit to reproduce the content; configured to establish a connection with the other terminal device in response to an operation performed by a user while the content is being reproduced; and configured to terminate the reproduction of the content once the connection with the third terminal device is established (Column 2, Lines 1-8).

Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ferber, Lee and Strietzel with the additional teaching of Lee of an incoming call detecting unit configured to detect an incoming call from a third terminal device; and a controlling unit configured to, if the incoming call detecting unit detects an incoming call from the third terminal device, cause the reproducing unit to reproduce the content; configured to establish a connection with the other terminal device in response to an operation performed by a user while the content is being reproduced; and configured to terminate the reproduction of the content once the connection with the third terminal device is established provide a user preferred ring tone (Column 1, Lines 49-51).

Referring to claim 4, Ferber further teaches wherein the server device makes a larger decrement in the second amount information the greater the number of times the content has been reproduced on the second terminal device (0020).

Referring to claim 5, Ferber further teaches wherein the server device makes a larger decrement in the second amount information the higher a reproduction volume of the content is on the second terminal device (0020). Volume is equated with quantity.

Referring to claim 6, Ferber further teaches wherein the server device decrements the second amount information only if the reproduction volume of the content on the second terminal device is greater than zero (0020). Volume is equated with quantity.

Referring to claim 8, Ferber further teaches wherein the server device selects user identification data from the second terminal device based upon distribution conditions applicable to the content transmitted from the first terminal device, and the server device transmits the content to the second terminal device (0024).

Referring to claims 9 and 31, Ferber further teaches wherein the server device downloads desired content to the user but does not teach providing a content list to the second terminal device and wherein the second terminal device has selecting unit configured to select from the content list. Lee teaches providing a content list to the second terminal device and wherein the second terminal device has selecting unit configured to select from the content list (Column 1, Lines 29-31). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Ferber, Lee and Strietzel with the additional teaching of Lee of providing a content list to the second terminal device and wherein

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the second terminal device has selecting unit configured to select from the content list to allow a user to preselect a ringtone (Column 1, Lines 29-31).

Referring to claims 11 and 33, Lee further teaches wherein the content is music data (Column 2, Lines 7-8).

Referring to claims 12 and 34, Ferber, Lee and Strietzel teach the limitations of claims 12 and 34, but do not teach wherein the content is promotion video data. However promotional video data at the time of the invention was well know, thus the Examiner takes official notice wherein the content is promotion video data. Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teaching of Ferber, Lee and Strietzel to include promotional video data to provide an easy to understand advertisement.

Referring to claims 13 and 35, Ferber further teaches wherein the provider is a content sponsor (Figure 4).

Referring to claims 14 and 36, Ferber further teaches wherein the second terminal device comprises a mobile communication terminal device (Figure 3, 324, 326, 328).

Referring to claims 15 and 37, Ferber further teaches wherein the second terminal device comprises a plurality of portable telephones (Figure 3, 324, 326, 328).



*Allowable Subject Matter*

3. Claims 7, 10, 28, 29, 30 and 32 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for allowable subject matter is indicated below:

Referring to claims 7 and 30, the references cited do not teach a data communication system according to claim 5, wherein the second terminal device comprises: a counting unit configured to count the number of times the content has been reproduced by the reproducing unit ; an accumulating unit configured to accumulate the reproduction volume in effect whenever the content is reproduced by the reproducing unit ; wherein, in each predetermined period of time, the controlling unit takes a counting result of the counting unit as the number of times the contents have been reproduced and transmits the number of times to the server device; and the controlling unit takes a division result of dividing an accumulation result of accumulating unit by the counting result as a content reproduction volume and transmits the content reproduction volume to the server device.

Referring to claims 10 and 32, the references cited do not teach wherein the second terminal device comprises a delete inhibit controlling unit configured to inhibit deletion of a content transmitted from the server device.

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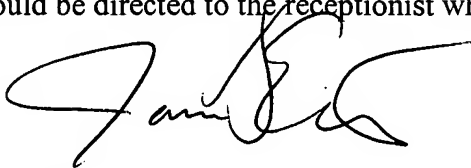
Referring to claim 28, the references cited do not teach wherein the controlling unit causes the communicating unit to transmit to the server device the number of times the content has been reproduced by the reproducing unit.

Referring to claim 29, the references cited do not teach wherein the controlling unit causes the communicating unit to transmit to the server device a volume of the content reproduced by the reproducing unit.

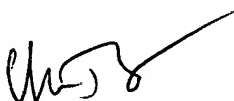
### ***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D. Ewart whose telephone number is (571) 272-7864. The examiner can normally be reached on M-F 7am - 4pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571)272-7872. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and (571) 273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2600.



James Ewart  
January 19, 2007



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